

REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-7, 9-15, and 17-29 were pending in the application, of which Claims 1, 6, and 25 are independent. In the Final Office Action dated October 15, 2007, Claims 1-7, 9-15, and 17-29 were rejected under 35 U.S.C. § 103(a). Following this response, Claims 1-7, 9-15, and 17-29 remain in this application. Applicant hereby addresses the Examiner's rejections in turn.

I. Interview Summary

Applicants thank Examiner Daye for her consideration of an interview, requested by the undersigned to discuss the rejection of the current claims under 35 U.S.C. § 103. Although the interview request was declined, Applicants maintain that the cited references neither anticipate nor render obvious the claims as amended, as evidenced by the Examiner's statement that the amended claims would require a new search.

II. Rejection of Claims 1, 6, and 25 Under 35 U.S.C. §112, First Paragraph

In the Final Office Action dated October 15, 2007, the Examiner rejected Claims 1, 6, and 25 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states being unable to locate, within the present application's description, details which explain the search query comprising a search query word, a list of electronic documents, and at least one folder containing the list of electronic documents. The Examiner further states that the search query comprises a search query word, that the particular word can then be retrieved from the

electronic document that a user wishes to search, and that the electronic document can include multiple electronic documents.

Applicant respectfully traverses this rejection. Applicant respectfully directs the Examiner to page 4, lines 19-21 of the specification, stating that the search method can accept a search query and the search method can determine if the query matches one or more sets of characters in multiple electronic documents. Applicant further directs the Examiner to page 3, lines 17-20 of the specification, stating that a character can also be retrieved from the electronic document that a user wishes to search and the electronic document can include multiple electronic documents and folders containing multiple electronic documents. Applicant further respectfully directs the Examiner to Figure 13 and page 24, lines 23-25 of the specification, stating that the YES branch is followed to step 1310, where the navigation component 285 directs the DEM UI 250 to the first document in the list of documents searched by the search query.

Applicant therefore respectfully submits that the search query as described in the specification comprises a list of electronic documents to be searched. As an electronic document may comprise a folder of electronic documents, and a search query may comprise a list of electronic documents to be searched, Applicant respectfully submits that a search query comprises all three elements as listed recited in Claims 1, 6, and 25. Accordingly, Applicant respectfully requests withdrawal of this rejection of Claims 1, 6, and 25.

III. Rejection of Claims 1-5 Under 35 U.S.C. §103(a)

In the Final Office Action, the Examiner rejected Claims 1-5 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,859,800 ("*Roche*") in view of U.S. Patent No. 6,111,985 ("*Hullender*") and further in view of U.S. Patent No. 5,832,474 ("*Lopresti*"). Claim 1 has been amended, and Applicant respectfully submits that the amendment overcomes this rejection and adds no new matter.

Amended Claim 1 is patentably distinguishable over the cited art for at least the reason that it recites, for example, "wherein each document in the list of electronic documents comprises a plurality of text and ink words", "determining if the document word is an ink word, and in response to determining that the document word is an ink word, conducting an ink word match", and "determining if the document word is a text word, and in response to determining that the document word is a text word, conducting a text word match." Support for these amendments can be found in the specification at least on page 2, lines 27-30.

In contrast, *Roche* at least does not teach or suggest the aforementioned recitations. For example, *Roche* merely discloses ranking matches based on a number of documents that contain a match and present the matches in order based on the number of matches. (See col. 13, lines 63-66.) As the Examiner states, *Roche* is silent with respect to accepting an ink word from the electronic document. (See Office Action, page 4, lines 16-18.) Consequently, *Roche* cannot disclose either determining if the word is an ink word or conducting a match on an ink word or documents comprising both text and ink words. Rather, *Roche* merely discloses presenting matches ranked in order based on the number of matches.

Furthermore, *Hullender* does not overcome *Roche*'s deficiencies. *Hullender* merely discloses recognizing handwritten characters previously entered into a system from a context of subsequent handwritten characters presently being entered into the system. (See *Hullender* col. 2, lines 37-40.) *Hullender* provides a pen-sensitive screen including a visible manifestation of a text buffer for displaying and allowing edit control of text characters that have been input and recognized. (See *Hullender*, col. 3, line 65 through col. 4, line 1.) *Hullender*'s pen input display areas receive handwritten characters from a user in stroke form, alternating input between two boxes. (See *Hullender*, col. 4, lines 25-30.) *Hullender*'s system considers a character to be entered when a user begins writing in a box and stops writing or directly commands the system to enter a character. (See *Hullender*, col. 6, lines 60-64.) Therefore, *Hullender*'s recognition process begins when an input character's data is received. (See *Hullender*, col. 6, lines 64-65.) *Hullender*, like *Roche*, does not disclose documents comprising both text and ink words. Rather, *Hullender* merely discloses recognizing handwritten characters as they are entered into a system.

Moreover, *Lopresti* does not overcome *Roche*'s and *Hullender*'s deficiencies. *Lopresti* merely discloses an electronic filing system supporting pen-based markup and annotation. (See *Lopresti*, Abstract, lines 1-2.) *Lopresti* permits user-drawn annotations to be readily incorporated into or associated with stored document without requiring duplication of the document. (See col. 2, lines 19-22.) *Lopresti*'s user-drawn annotations can be searched as part of a document retrieval query. (See col. 2, lines 22-23.) These annotations in *Lopresti* become associated with a stored document and may be searched to later retrieve the document. (See col. 2, lines 26-28.) However,

nowhere does *Lopresti* disclose determining if a word in a document is a text or ink word and conducting a match accordingly. *Lopresti* merely discloses associating pen-based annotations with a document.

Combining *Roche* with *Hullender* and *Lopresti* would not have led to the claimed invention because *Roche*, *Hullender*, and *Lopresti*, either individually or in combination, at least do not disclose or suggest "wherein each document in the list of electronic documents comprises a plurality of text and ink words", "determining if the document word is an ink word, and in response to determining that the document word is an ink word, conducting an ink word match", and "determining if the document word is a text word, and in response to determining that the document word is a text word, conducting a text word match," as recited by amended Claim 1. Accordingly, independent Claim 1 patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claim 1.

Dependent Claims 2-5 are also allowable at least for the reasons described above regarding independent Claim 1, and by virtue of their dependency upon independent Claim 1. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 2-5.

IV. Rejection of Claims 6-7, 9, 12-15, and 17-29 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected Claims 6-7, 9-15, and 17-29 under 35 U.S.C. §103(a) as being unpatentable over *Roche* in view of U.S. Patent No. 4,832,474 ("*Lopresti*"). Furthermore, the Examiner rejected Claims 10-11 under 35 U.S.C. §103(a) as being unpatentable over *Roche* in view of *Lopresti* further in view of Software Patent

Institute Database of Software Technologies, Published 1997 ("SPI"). Claims 6 and 25 have been amended, and Applicant respectfully submits that these amendments overcome this rejection and add no new matter.

Amended Claim 6 is patentably distinguishable over the cited art for at least the reason that it recites, for example, "wherein each document in the list of electronic documents comprises a plurality of text and ink words", "determining if the document word is an ink word, and in response to determining that the document word is an ink word, conducting an ink word match", and "determining if the document word is a text word, and in response to determining that the document word is a text word, conducting a text word match." Amended Claim 25 includes a similar recitation. Support for these amendments can be found in the specification at least on page 2, lines 27-30.

In contrast, as stated above, *Roche* at least does not teach or suggest the aforementioned recitations. For example, *Roche* merely discloses ranking matches based on a number of documents that contain a match and present the matches in order based on the number of matches. (See col. 13, lines 63-66.) As the Examiner states, *Roche* is silent with respect to accepting an ink word from the electronic document. (See Office Action, page 4, lines 16-18.) Consequently, *Roche* cannot disclose either determining if the word is an ink word or conducting a match on an ink word or documents comprising both text and ink words. Rather, *Roche* merely discloses presenting matches ranked in order based on the number of matches.

As further stated above, *Lopresti* does not overcome *Roche*'s deficiencies. *Lopresti* merely discloses an electronic filing system supporting pen-based markup and annotation. (See *Lopresti*, Abstract, lines 1-2.) *Lopresti* permits user-drawn

annotations to be readily incorporated into or associated with stored document without requiring duplication of the document. (See col. 2, lines 19-22.) *Lopresti's* user-drawn annotations can be searched as part of a document retrieval query. (See col. 2, lines 22-23.) These annotations in *Lopresti* become associated with a stored document and may be searched to later retrieve the document. (See col. 2, lines 26-28.) However, nowhere does *Lopresti* disclose determining if a word in a document is a text or ink word and conducting a match accordingly. *Lopresti* merely discloses associating pen-based annotations with a document.

Combining *Roche* with *Lopresti* would not have led to the claimed invention because *Roche*, *Hullender*, and *Lopresti*, either individually or in combination, at least do not disclose or suggest "wherein each document in the list of electronic documents comprises a plurality of text and ink words", "determining if the document word is an ink word, and in response to determining that the document word is an ink word, conducting an ink word match", and "determining if the document word is a text word, and in response to determining that the document word is a text word, conducting a text word match," as recited by amended Claim 6. Amended Claim 25 includes a similar recitation. Accordingly, independent Claims 6 and 25 each patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claims 6 and 25.

Dependent Claims 7, 9-15, 17-24, and 26-29 are also allowable at least for the reasons described above regarding independent Claim 6 and 25, and by virtue of their

respective dependencies upon independent Claims 6 and 25. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 7, 9-15, 17-24, and 26-29.

V. Conclusion

Applicant respectfully requests that this Amendment After Final be entered by the Examiner, placing the claims in condition for allowance. Applicant respectfully submits that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicant respectfully submits that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant respectfully submits that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In view of the foregoing, Applicant respectfully submits that the pending claims, as amended, are patentable over the cited references. The preceding arguments are based only on the arguments in the Official Action, and therefore do not address

patentable aspects of the invention that were not addressed by the Examiner in the Official Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

Please grant any extensions of time required to enter this amendment and charge any additional required fees to our Deposit Account No. 13-2725.

Respectfully submitted,
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